

to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate by reference all the arguments presented in the *Amendment* filed February 28, 2005 (received by OIPE March 2, 2005).

The Applicants respectfully submit that the alleged obviousness rejection based on Sato is inappropriate for at least the following reasons:

1. Lack of Sufficient Motivation to Modify Sato.

The Official Action has failed to provide sufficient motivation to carry out all of the extensive modifications to Sato that are discussed at pages 2-17 of the Official Action mailed August 11, 2005, and at pages 2-25 of the Official Action mailed October 27, 2004. Specifically, it is not clear why one of ordinary skill in the art at the time of the present invention would have been motivated to change an admittedly inoperative device in the manner proposed by the Official Action.

Instead of providing one or more references which teach or suggest all the features of the claims of the present application, the Official Action has provided a detailed hypothetical demonstration of how someone might modify a single reference,

Sato. The rejection appears to be based on a theory that if a reference is inoperative, then one would be motivated to fix it so that it works. The Official Action then provides a long list of assumptions that could have been applied to Sato to make it operable and asserted that this hypothetical modified device renders obvious the claims of the present application. However, the reasoning in the Official Action fails to show why it would have been obvious to make all the proposed changes to make Sato an operative device.

## 2. Impermissible Hindsight Vision.

The Official Action relies on alleged modifications that “occur to the Examiner” (page 4). Without a teaching from the prior art, in order to form a *prima facie* case of obviousness, it may be possible to rely on common knowledge that would have been available to one of ordinary skill in the art at the time of the present invention, but this determination must be made “without the benefit of impermissible hindsight vision afforded by the claimed invention” (MPEP § 2141; see also MPEP § 2141.01.III and § 2142).

A commonly invoked response to an allegation of hindsight involves a citation from MPEP § 2145.X.A, as follows: “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper” In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (emphasis added).

It appears the Official Action has included knowledge well beyond that which was within the level of ordinary skill in the art at the time the claimed invention was made. Furthermore, the Official Action appears to have made inferences that could have only been gleaned from Applicants’ disclosure.

3. Inappropriate Use of Alleged Inherency, Common Knowledge or Practice, and Notoriously Well Known Teachings.

Without any specific reference in support, the Official Action relies on assertions that “conditions must exist” (Id.), on allegedly “inherent” features (pages 8, 11, 16), on “common knowledge in the art” (pages 11, 15), on allegedly “notoriously well known” features (pages 12, 16), on “common practice in the art” (page 13) and on an assertion that Sato “must be modified” (page 15).

However, the Federal Circuit reversed a rejection based on inherency, which was based on what would result due to optimization of conditions, not what was necessarily present in the prior art. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). The Official Action has not shown that alleged modifications (discussed at pages 2-17 of the Official Action mailed August 11, 2005, and at pages 2-25 of the Official Action mailed October 27, 2004) were necessarily present in the prior art at the time of the present invention.

Although the Official Action has not formally invoked Official Notice, it appears that the assertions in the Official Action are not based on prior art references. Regarding use of Official Notice, MPEP § 2144.03 states the following: “It would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” Also, the CCPA explicitly rejected “the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.” In the present application, the Applicants respectfully submit that the Official Action has not shown that the extensive modifications to Sato (discussed at pages 2-17 of the Official Action mailed August 11, 2005, and at pages 2-25 of the Official Action mailed October 27, 2004), are capable of instant and unquestionable demonstration as being well-known.

4. Question of Inoperability of Sato is not Clear.

Every patent is presumed valid (35 U.S.C. § 282). The patenting process is time-consuming, and it is not common for an inventor to pursue protection of an inoperative device. Further, the Sato reference was published January 10, 1978, and the present application was filed February 11, 1999, a span of over 21 years. If Sato were truly inoperative and demanded modification, it would seem logical that one of ordinary skill in the art would have proposed a modification to Sato in the 21 year period spanning between the present application and Sato; however, no such reference has been provided and none is believed to exist. Also, it is noted that the analysis in the Official Action is based on a translation that is admitted to be of poor quality. It is not clear that the alleged inoperability is not simply the result of a translation error. It is also not clear whether the numerous modifications proposed in the Official Action are based on assumptions, which themselves are based on a faulty translation. Therefore, the Applicants respectfully submit that the question of the inoperability of Sato has not been clearly established.

In the present application, it is respectfully submitted that Sato does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Sato.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.